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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,141	02/04/2002	Joyce B. Palazzotto	50142US010	7314

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EXAMINER

LEWIS, AARON J

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/067,141

Applicant(s)

PALAZZOTTO ET AL.

Examiner

AARON J. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Arguments***

1. In view of the applicants' arguments filed on 04/21/2003, PROSECUTION IS HEREBY REOPENED. The reasons are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

On page 6, beginning in line 3, applicants noted that the portion "and into an interior of said face mask" of that phrase does not appear in either claim 19 or claim 20 of the present application. Rather, independent claims 19 and 20 both recite "...a spacer further having a microphone extending therefrom and into a clean air envelope of said face mask...".

A review of the Final rejection of 07/22/2002, page 2, reveals the assertion by the examiner that the phrase "and into an interior of said face mask" appears in the claims; however, a review of the claims (i.e. specifically claims 19 and 20) of the instant application reveals that the phrase "and into an interior of said face mask" does not appear in either claim. In an effort to properly

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address the wording of each claim (i.e. specifically with respect to claims 19 and 20) in the instant application in an accurate manner, prosecution is being re-opened.

***Claim Rejections - 35 USC § 112***

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-20 include language which is not supported by the specification as originally filed. That language includes the terminology "...said spacer further having a microphone extending therefrom;..."; and "...a microphone extending therefrom and into a clean air envelope of said face mask...".

Figures 5 and 6 of the instant application illustrate microphone 74 situated WITHIN the confines of the so called spacer 50. Neither drawing figures 5 and 6 nor the instant specification disclose a microphone extending THEREFROM. The microphone being situated within the confines of the spacer as disclosed and illustrated by the instant application differs from the arrangement in Birli et al. ('693) patent which illustrates microphone 20 extending THEREFROM [the spacer element 18] (fig.2) and which illustrates microphone 20 extending THEREFROM AND INTO AN INTERIOR OF THE FACE MASK (fig.3).

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### *Interference*

3. Claims 1-20 of this application has been copied from U.S. Patent No. 5,463,693 for the purpose of an interference. These claims are not patentable to the applicant for the following reasons:

An interference cannot be initiated since a prerequisite for interference under 37CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

Claims 7 and 16 recite that the spacer is constructed of a "plastic material" whereas claim 7 of patent ('693) recites "...a thermoplastic material...". One of ordinary skill would recognize thermoplastic materials to refer to synthetic resins that may be softened by heat, and then regain their original properties upon cooling whereas not all plastic materials exhibit this property.

Each of claims 19 and 20 recites "...a clean air envelope..." (in line 8 and 7 respectively) whereas each of claims 19 and 20 of patent ('693) recites "...an interior space...". The term "clean air envelope" is not an equivalent substitute for the term "...interior space..." as used in patent ('693). The "clean air envelope" in the instant application defines the combination of space within the face mask and space within spacer 50 whereas "interior space" [of the face mask] in patent ('693) defines space within the face mask 14 exclusive of the space within spacer 18. Applicant's attention is invited to lines 2,3 and 9,10 of claim 19 in patent ('693) which initially defines a face mask having an inhalation port through which a wearer of the mask inhales ambient air and subsequently defines a microphone extending therefrom [spacer 18] and into an interior space of said face mask. The claimed interior space of said face mask is physically different from the

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combination of space within the face mask and the space within spacer 50 of the instant application. Consequently, these terms "clean air envelope" and "interior space" are not interchangeable equivalent elements.

4. Claims 1-20 of this application is asserted by applicant to correspond to claim(s) of U.S. Patent No. 5,463,693.

The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No. 5,463,693 because of the differences between the claims submitted as copied and the actual claims 1-20 of patent ('693) as pointed out above. Accordingly, an interference cannot be initiated based upon these claims.

Further, it is submitted that claims 1-20 of patent ('693) do not define the same subject matter as is set forth in the disclosure of the instant application. Claims 1-20 of patent ('693) include at least one major difference with the the disclosure of the instant application. In claims 1 and 10 of patent ('693) the recitation "...said spacer further having a microphone extending therefrom;..." and in claims 19 and 20, the recitation "...a microphone extending therefrom and into an interior of said face mask...", each defines a microphone which extends FROM a spacer and a microphone which extends from a spacer and INTO an interior of the face mask. The element recited in the claims of the instant application which may be readable upon the microphone of patent ('693) is "...speech reception means...". The "...speech reception means..." as defined in the claims of the instant application is neither recited to extend from a spacer nor extend from a spacer and into the interior of a face mask. Even if the phrase "...extending therefrom..." might be interpreted as


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defining a microphone which extends in any direction to any extent from a spacer, a reading of the claim language in light of the specification and drawings of patent ('693) reveals that the microphone has only one intended orientation which is within the interior of the face mask.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Lewis whose telephone number is (703) 308-0716.

Aaron J. Lewis

June 30, 2003

  
Aaron J. Lewis  
Primary Examiner

  
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SUPERVISORY PATENT EXAMINER  
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